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AUSTRALIA

In re Application of
SMALL
Serial No.: 10/509,297
PCT No.: PCT/AU02/00413
Int. Filing Date: 28 March 2002
Priority Date: 28 March 2002
Atty Docket No.: None
For: THERMAL STORAGE DEVICE

DECISION ON PETITION

UNDER 37 CFR 1.47(b)

This decision is in response to applicant's "Petition to Permit Filing Under 37 CFR 1.47(b)" filed 20 May 2005 to accept the application without the signature of inventor Barry James Small.

BACKGROUND

On 28 March 2002, applicant filed international application PCT/AU02/00413. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 September 2004.

On 28 September 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment. An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 29 March 2005, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of \$130.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 20 May 2005, applicant responded with the present petition.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (3), (5) and (6).

Regarding item (1), applicant has not provided payment of the \$200.00 petition fee.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal:

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature...it is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is appraised of the application to which the oath or declaration is directed. *In re Gray* 115 USPQ 80 (Comm'r Pat. 1956).

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

It is clear from applicant's petition and supporting material that a set of the application papers and oath or declaration have not been presented or mailed to the inventor. Applicant seeks a waiver of this requirement. Applicant's present filing does not support such a waiver. Item 17 of the petition states that a recording of some of threats from Mr. Small to Mr. Paton is attached to the petition and item 18 explains that the police and solicitor have advised that all contact with Mr. Small should be terminated. However, the referenced documentation was not in the petition.

In addition, regarding contact with Mr. Small, it is possible that counsel could mail a set of the application papers to Mr. Smith. Absent a mailing of the papers to Mr. Smith, and his subsequent silence or refusal, applicant would need to provide documentation from the police as to the incidents investigated by the police and their recommendation not to contact Mr. Small and whether this advice extended to mailings from the corporation and/or the company's agents.

Regarding item (4), the filed declaration has been executed by Garth Alan Paton on behalf of the corporation and on behalf of the non-signing inventor. However, while the petition spells out Mr. Paton's title and right to execute the declaration on behalf of the corporation, this information is missing from the declaration itself. As explained in the Manual of Patent Examining Procedure at § 409.03(b):

Where an application is executed by one other than the inventor, the declaration required by 37 CFR

1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

(B) The 37 CFR 1.47(b) applicant must state his or her relationship to the inventor as required by 37 CFR 1.64.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, **without prejudice**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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